

REMARKS

This Application has been carefully reviewed in light of the final Office Action mailed January 11, 2005 (the "Office Action"). At the time of the Office Action, Claims 1-5, 7-10, and 23-32 were pending in the Application. Applicants amend Claims 1, 23, and 32. Applicants respectfully request reconsideration and favorable action in this case.

Specification Objection

Applicants have amended the specification to reference communication path 602 as illustrated in Figure 6. Applicants respectfully request withdrawal of the objection to the specification.

Claim Rejections

The Office Action rejects Claims 1-5, 23-27, and 32 under 35 U.S.C. §103(a) as being unpatentable over U. S. Patent No. 6,307,837 Ichikawa et al. ("*Ichikawa*") in view of U.S. Publication No. 2004/0077349 Barak et al. ("*Barak*") and in further view of U.S. Publication No. 2003/0119500 Mukherjee et al. ("*Mukherjee*") and in further view of U.S. Publication No. 2002/0123365 Thorson et al. ("*Thorson*"). Applicants respectfully traverse these rejections.

Claims 1, 23 and 32 recite a public switched data network (PSDN) gateway comprising a T1 trunk interface for communication with a PSDN, a public switched telephone network (PSTN) gateway comprising a T1 trunk interface for communication with a PSTN and a public land mobile network (PLMN) gateway comprising a T1 trunk interface for communication with a PLMN. None of the references cited in the rejections of these claims include these elements. Applicants note that the Office Action references U.S. Patent No. 6,407,996 issued to Witchalls ("*Witchalls*") in rejecting Claims 7-8 and 28-29 which recite a plurality of T1 trunks. *Witchalls* discloses a PSTN gateway computer 304 connected to a PSTN over a trunk line 312. See *Witchalls*, col. 7, lines 36-37 and Figure 8. However, *Witchalls* does not disclose, teach or suggest a "T1 trunk" interface for communicating with a PSTN; nor does *Witchalls* disclose, teach or suggest T1 trunk interfaces of a PSDN or PLMN gateway that is coupled to a LAN coupled to a plurality of wireless base stations. Therefore,

Applicants respectfully submit that Claims 1, 23 and 32 are patentable over the cited art used in the rejections and request that the rejections of Claims 1, 23 and 32 be withdrawn.

In addition, the Office Action has combined under 35 U.S.C. § 103 at least four different references in the rejection of each pending claim. The M.P.E.P. sets forth the strict legal standard for establishing a *prima facie* case of obviousness based on modification or combination of prior art references.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references where combined) must teach or suggest all the claim limitations.

M.P.E.P. § 2142, 2143. The teaching, suggestion, or motivation for the modification or combination and the reasonable expectation of success must both be found in the prior art and cannot be based on an applicant's disclosure. *See id.* (citations omitted). "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art" at the time of the invention. M.P.E.P. § 2143.01. Even the fact that references *can* be modified or combined does not render the resultant modification or combination obvious unless the prior art teaches or suggests the desirability of the modification or combination. *See id.* (citations omitted). Moreover, "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. All words in a claim must be considered in judging the patentability of that claim against the prior art." M.P.E.P. § 2143.03 (citations omitted).

The governing Federal Circuit case law makes this strict legal standard even more clear.¹ According to the Federal Circuit, "a showing of a suggestion, teaching, or motivation to combine or modify prior art references is an essential component of an obviousness holding." *In re Sang-Su Lee*, 277 F.3d 1338, 1343, 61 U.S.P.Q.2d 1430, 1433 (Fed. Cir.

¹ Note M.P.E.P. 2145 X.C. ("The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.").

2002) (quoting *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 U.S.P.Q.2d 1456, 1459 (Fed. Cir. 2000)). "Evidence of a suggestion, teaching, or motivation . . . may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved." *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). However, the "range of sources available . . . does not diminish the requirement for actual evidence." *Id.* Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." *In re Mills*, 916 F.2d at 682, 16 U.S.P.Q.2d at 1432. *See also In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998) (holding a *prima facie* case of obviousness not made where the combination of the references taught every element of the claimed invention but did not provide a motivation to combine); *In Re Jones*, 958 F.2d 347,351,21 U.S.P.Q.2d 1941, 1944 (Fed. Cir. 1992) ("Conspicuously missing from this record is any evidence, other than the PTO's speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at" the claimed invention.). Even a determination that it would have been obvious to one of ordinary skill in the art at the time of the invention to try the proposed modification or combination is not sufficient to establish a *prima facie* case of obviousness. *See In re Fine*, 837 F.2d 1071, 1075,5 U.S.P.Q.2d 1596, 1599 (Fed. Cir. 1988).

In addition, the M.P.E.P. and the Federal Circuit repeatedly warn against using an applicant's disclosure as a blueprint to reconstruct the claimed invention. For example, the M.P.E.P. states, "The tendency to resort to 'hindsight' based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art." M.P.E.P. § 2142. The governing Federal Circuit cases are equally clear. "A critical step in analyzing the patentability of claims pursuant to [35 U.S.C. § 103] is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. . . . Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one 'to fall victim to the insidious effect of a hindsight syndrome wherein that which

only the invention taught is used against its teacher." *In re Kotzab*, 217 F.3d 1365, 1369, 55 U.S.P.Q.2d 1313, 1316 (Fed. Cir. 2000) (citations omitted). In *In re Kotzab*, the Federal Circuit noted that to prevent the use of hindsight based on the invention to defeat patentability of the invention, the court requires the Examiner to show a sufficient motivation in the prior art to combine the references that allegedly create the case of obviousness. *See id.* *See also, e.g., Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 U.S.P.Q.2d 1788, 1792 (Fed. Cir. 1988). Similarly, in *In re Dembiczak*, the Federal Circuit reversed a finding of obviousness by the Board, explaining that the required evidence of such a teaching, suggestion, or motivation is essential to avoid impermissible hindsight reconstruction of an applicant's invention:

Our case law makes clear that the best defense against the subtle but powerful attraction of hind-sight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability-the essence of hindsight.

175 F.3d at 999, 50 U.S.P.Q.2d at 1617 (emphasis added) (citations omitted).

The Office Action repeatedly contends that the motivation to combine particular references is so that the resulting combination includes the particular claim element missing in the base reference. This is the essence of hindsight reconstruction prohibited by the M.P.E.P. and the Federal Circuit. For example, *Ichikawa* does not disclose a PSTN gateway directly coupled to a LAN to communicate with a wireless device through a wireless base station, but the Office Action states that it would have been obvious to employ *Barak* in *Ichikawa* "to have the PSTN gateway directly coupled to the LAN so that the LAN can handle the transfer of information between the PSTN gateway and the base stations." Office Action, page 4. Similarly, *Ichikawa-Barak* does not disclose a PLMN gateway directly coupled to a LAN to communicate with a wireless device through a wireless base station, but the Office Action states that it would have been obvious to employ *Mukherjee* in *Ichikawa-Barak* "to have the PLMN gateway directly coupled to the LAN so that the LAN can handle the transfer of information between the PLMN gateway and the base stations." Office Action, page 4.

Applicants respectfully submit that the Office Action's conclusory assertions that it would have been obvious to combine the various references as suggested to arrive at Applicants' invention is entirely insufficient to support a *prima facie* case of obviousness under 35 U.S.C. § 103(a) under the M.P.E.P. and the governing Federal Circuit case law.

Claims 2-5 and 7-10 each depends, either directly or indirectly, from Claim 1; and Claims 24-31 each depends, either directly or indirectly, from Claim 23. Thus, for at least the reasons discussed above with respect to Claims 1 and 23, Applicants respectfully request that the rejections of Claims 2-5, 7-10 and 24-31 be withdrawn.

In addition, in the rejections of Claims 7-8 and 28-29, the Office Action states that *Ichikawa-Barak-Mukherjee-Thorson* with *Witchalls* does not disclose PSTN or PSDN gateways having a plurality of T1 trunks but that it would have been obvious to employ *Witchalls* in *Ichikawa-Barak-Mukherjee-Thorson* "to obtain a PSTN (or PSDN) gateway to include a plurality of T1 trunks" "to allow access (communication) between the PSTN (or PSDN) network and the PSTN (or PSDN) gateway through the use of T1 trunk lines." Office Action, pages 10-11. Again, the Office Action contends that the motivation to combine particular references is so that the resulting combination includes the particular claim element missing in the base reference which is improper under the M.P.E.P. and Federal Circuit caselaw. For at least these additional reasons, Applicants respectfully request that the rejections of Claims 7-8 and 28-29 be withdrawn.

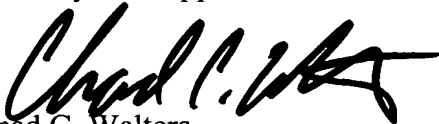
CONCLUSION

Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request full allowance of all pending claims.

If the present application is not allowed and/or if one or more of the rejections is maintained, Applicants hereby request a telephone conference with the Examiner and further request that the Examiner contact Chad C. Walters, Attorney for Applicants, at the Examiner's convenience at (214) 953-6511 to schedule the telephone conference.

Applicants believe no fees are due. However, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,
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